

REMARKS

Claims 1-10 are now pending in the application. Of these pending claims, Claims 5-10 are new. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

REJECTION UNDER 35 U.S.C. § 103

Claims 1-4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over anticipated by Japanese 11-223207 in view of Mizuno et al. (U.S. Pat. No. 6,443,678) and further in view of Bodin (U.S. Pat. No. 6,146,076). This rejection is respectfully traversed.

In rejection of Claims 1-4, the Office Action cites *In re Leshin*, 125 U.S.P.Q. 416 for the proposition that the selection of known materials on the basis of suitability for the intended use is a matter of obvious design choice. The Applicants respectfully assert that this proposition has been inappropriately applied to the Applicants' claimed invention. The United States Supreme Court in *Smith v. Goodyear Dental Vulcanite Co.*, 93 U.S. 486, 496, 497, 23 L. Ed. 952, stated:

“But where there is some new and useful result, where a machine has acquired new functions and useful properties it may be patentable as an invention, though the only change made in the machine has been supplanting one of its materials by another.”

This exception has been cited in many cases including *United Shoe Machinery Corporation v. E.H. Ferree Co.* (C.C.A.), 64 F.2d 101, certiorari granted, 290 U.S. 614, 54 S.Ct. 69, 78 L.Ed. 537, dismissed per stipulation of counsel, 290 U.S. 708. (substitution of aluminum for cast iron in the hammer arm of a clicking machine used in the cutting of shoe uppers).

Applicants acknowledge that merely substituting superior for inferior materials in making one or more or all of the parts of a machine is not an invention, unless the substitution results in a new and useful result, an increase in efficiency or decided saving in efficiency. *Hicks v. Kelsey*, 18 Wall. 670, 673 21 L.Ed. 852.

"It is also the law, as exceptions to this general rule, that if the substitution involved a new mode of construction; or if it developed new properties and uses of the article made; or where it produces a new mode of operation, or results in a new function; or when it is the first practical success in the art in which the substitution is made; or where the practice shows its superiority to consist not only in greater cheapness and greater utility, but also in more effective action, it may amount to an invention."

Gasoline Products Co., Inc., v. C.O.E., Commissioner of Patents, (D.C. Cir), 87 F.2d. 550, 557.

As stated in Paragraph [20] of the instant application, "...In an experimental test, the fastener of the present invention and a conventional chloroprene rubber fastener each fastened to a workpiece were applied with ozone having a concentration or density of 50 ± 5 pphm at temperature of 40 ± 2 degrees at centigrade ($^{\circ}\text{C}$) for 96 hours. As a result, the elastomeric fastener of the present invention had no crack. In contrast, the conventional chloroprene rubber fastener (Hs A 70: Shore hardness A = 70) had cracks around the base of the expanded portion. The fastener of the present invention also has a vibration resistance superior to the chloroprene rubber fastener, as described later."

Further, as shown in paragraph [28] "In the graph of Figure 8, it can be seen that the conventional chloroprene rubber fastener has variances in the output acceleration and unstable insulation performance in the shearing direction. Particularly in the conventional chloroprene rubber fastener, the output acceleration is significantly varied

and the maximum resonance is produced around 900 Hz. In contrast, the fastener of the present invention has generally lower output acceleration and exhibits desirably stable vibration insulation performance without any notable output as in the conventional fastener. This proves that the fastener of the present invention has a high vibration insulation performance. In another test where a vibration was applied in a compression direction (along the axial direction), the substantial same result could be obtained".

As can be seen, the substitution of the materials does involve a new mode of construction and its practice shows its superiority to consist not only in greater cheapness and greater utility, and is also in more efficient action. Therefore, Applicants assert this substitution is non-obvious.

Applicants would like to direct the Examiner's attention to independent Claims 1 and 5. Both independent claims contains the limitation the polymer fastener is formed of two separate structures. The first being an elastic material, configured to be deformed. The second material being relatively ridged and being threaded to accept a threaded fastener. Further, Applicants note that while the references cited teach a monolithic deformable bodies, none of the references teach a two-piece polymer fastener having an elastic exterior body with an internally bonded threaded portion formed of a second material.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1243.

Respectfully submitted,

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By: 
Christopher A. Eusebi
Reg. No. 44,672

HARNESS, DICKEY & PIERCE, P.L.C.
P.O. Box 828
Bloomfield Hills, Michigan 48303
(248) 641-1600

CAE/smb